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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,643	04/22/2004	Robert Andrew Gall		6963

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RICHARD D. CLARKE
LAW OFFICE OF RICHARD D. CLARKE
3755 AVOCADO BLVD., #1000
LA MESA, CA 91941-7301

EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/829,643	Applicant(s) GALL, ROBERT ANDREW	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11, 15 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 15 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. None of the method steps recited in claims 21 or 22 are disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 21, subparagraphs “b)” and “c)” appear to be mutually exclusive, but are presented as cumulative. It is also not clear what the phrase “providing an insert” means. It would appear to refer to a separate physical entity that is attached to an existing license plate. But Applicant’s disclosure does not include such a device. Further, the statement that the non-alphanumeric indicia “satisfies government requirements” makes it impossible to ascertain the scope of the claim because it is not specified which government’s requirements are met. There are, after all, many governments, both domestic and foreign, that regulate the registration of

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motor vehicles. Further, because government requirements are subject to change over time, the scope of the claim would be subject to change over time, too, which is improper.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10, 11, 15 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by *DMV*.

The *DMV* reference shows that at least a year before the filing of the instant application the North Carolina Department of Motor Vehicles, a government agency, approved the issuance of official license plates including non-alphanumeric identification indicia. The “North Carolina State University” page of the North Carolina Department of Motor Vehicles website shows that the license plates issued by North Carolina at that time were the standard aluminum license plates that have been in use for decades. The recitation that the indicia is “used for vehicle identification” is merely a statement of intended use and does not distinguish over the prior art.

Regarding claim 11, the non-alphanumeric indicia approved by the North Carolina Department of Motor Vehicles included the dollar sign and the question mark.

Regarding claim 15, the reason for making the license plate is irrelevant to the method of making that plate.

Regarding claim 21, *DMV* discloses a method of displaying identification indicia on a government issued vehicle license plate, the indicia including non-alphanumeric indicia that can

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be used in addition to, or in place of, alphanumeric indicia. The limitation “whereby said non-alphanumeric identification indicia satisfies government requirements for the license plate function of vehicle identification” appears to be the heart of Applicant’s invention. Applicant is trying to patent the idea of using non-alphanumeric indicia as part of a vehicle’s official state registration. Applicant alleges that although the state of North Carolina issues official license plates that include non-alphanumeric indicia, that indicia is not included in the vehicle’s official registration indicia. But the decision not to include the non-alphanumeric indicia in the vehicle’s official registration requires knowing that such indicia could have been included. Further, North Carolina Statute §20-79.4(b)(32) states that only “the letters or letters and numbers requested by the owner” can be included on personalized license plates. The fact that the North Carolina Department of Motor Vehicles allows non-alphanumeric indicia on personalized license plates that are not part of the official registration number set forth in the statute informs the public of two things: 1) it is known to provide non-alphanumeric indicia on a license plate, and 2) those symbols are not part of the official vehicle registration number. But in the very act of informing the public “idea A is allowed, but idea B is not,” the public is informed of both “idea A” and “idea B.” Therefore, the idea of using non-alphanumeric indicia for an official vehicle registration, the idea for which Applicant seeks a patent, was disclosed to the public by the very act of prohibiting it.

4. Claims 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by “maham76”.

“maham76” discloses a government-issued vehicle license plate for identifying vehicles comprising a metallic plate for the purpose of displaying identification indicia, and a

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combination of alpha-numeric and non-alphanumeric identification indicia displayed on the metallic plate.

Regarding claim 11, the non-alphanumeric indicia is a lightning bolt symbol.

5. Claims 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by “Live Free or Die”.

“Live Free or Die” discloses a government-issued vehicle license plate for identifying vehicles comprising a metallic plate for the purpose of displaying identification indicia, and a combination of alpha-numeric and non-alphanumeric (i.e., an ampersand) identification indicia displayed on the metallic plate.

6. Claims 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by *The Plate Hut* (hereinafter “Hut”).

“Hut” discloses a government-issued vehicle license plate for identifying vehicles comprising a metallic plate for the purpose of displaying identification indicia, and a combination of alpha-numeric and non-alphanumeric (i.e., two dashes) identification indicia displayed on the metallic plate.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over *The Plate Hut* (hereinafter “Hut”) in view of *The Complete Information Gathering Tutorial* (hereinafter “Tutorial”).

“Hut” discloses a license plate that includes a combination of non-alphanumeric identification indicia (i.e., two dashes). “Tutorial” teaches that it was known in the art to determine ownership of a vehicle by comparing the license plate identifier with vehicle registration records (see the last paragraph of page 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to read the license plate disclosed by “Hut” and compare its identification indicia to known vehicle registration records, as taught by “Tutorial,” in order to determine ownership of the vehicle.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Internet License Plate Gallery* (hereinafter “Gallery”) in view of *The Complete Information Gathering Tutorial* (hereinafter “Tutorial”).

“Gallery” discloses a license plate that includes a combination of non-alphanumeric identification indicia (page 3, plate number “#!PERL”). “Tutorial” teaches that it was known in the art to determine ownership of a vehicle by comparing the license plate identifier with vehicle registration records (see the last paragraph of page 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to read the license plate disclosed by “Gallery” and compare its identification indicia to known vehicle registration records, as taught by “Tutorial,” in order to determine ownership of the vehicle.

The license plate disclosed by “Gallery” was issued in North Carolina, and Applicant has stated that he has proof that North Carolina does not consider the non-alphanumeric indicia to be

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part of the vehicle's official license plate number. However, the question of obviousness does not hinge on what has actually been done, but on what would have been obvious to do. It is well known that the indicia appearing on license plates is the official identification of the vehicle. Displaying such indicia has been the purpose of license plates for as long as license plates have been in use. Therefore, a person seeing the license plate "#!PERL" would assume that the vehicle's official identification is "#!PERL." If the state of North Carolina has made an administrative decision that it will exclude the non-alphanumeric indicia from the official identification of the vehicle, that does not change the fact that its inclusion would have been obvious. Indeed, the state's decision was counter-intuitive and non-obvious. Further, it is not as if the state of North Carolina didn't know it could have chosen to include the non-alphanumeric indicia if it had wanted to, and it needed Applicant's disclosure to teach it that it could. On the contrary, if, as Applicant alleges, the state decided not to use the non-alphanumeric indicia as part of the official license plate number, that was merely an administrative decision. It would have been obvious instead to have used all of the indicia on the license plate as the official identification, because that is what is commonly done. Whoever made the decision to exclude the non-alphanumeric indicia from the official identification had to first conceive of including it, in order to decide not to. If, at some future date, the state of North Carolina changes its mind and decides to incorporate the non-alphanumeric indicia in the vehicle's official identification, Applicant is not entitled to prevent the state from doing so by obtaining a patent on the method of identification that North Carolina deliberately decided not to use.

Response to Arguments

10. Applicant's arguments filed December 29, 2005 have been fully considered but they are not persuasive.

Regarding the *DMV* reference, Applicant states that “the indicia disclosed in the *DMV* reference is decorative indicia and not identification indicia.” Whether or not that is true, it is irrelevant to the patentability of claims 10 and 11. Those claims are drawn to the license plate itself. The claimed license plate existed more than one year prior to the filing of this application, and therefore, it is not patentable to Applicant.

Applicant's argument in the first full paragraph on page 8 is not understood. The North Carolina Department of Motor Vehicles (NCDMV), like similar departments in other states, refuses to issue personalized license plates containing letter combinations that spell obscene words, for example. That has nothing whatsoever to do with the use or non-use of non-alphanumeric identification indicia.

Applicant states, “because identification indicia, a specific type of indicia used on license plates, was not disclosed in the *DMV* reference, which only disclosed decorative indicia, it is Applicant's belief that claim 10 is not anticipated by the *DMV* reference.” On the contrary, the *DMV* references discloses exactly the indicia that applicant discloses. Calling it “identification indicia” as if that distinguishes it somehow from exactly the same indicia, only now called “decorative indicia,” reflects merely an intended use, which is not relevant to the patentability of the article itself. Applicant is not entitled to receive a patent for exactly the same pre-existing article merely by describing it with a different adjective.

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Regarding claim 15, this is still presented as “a method for making” a license plate. A method of making might involve such steps as stamping, cutting, embossing, painting, etc. But Applicant has not set forth a single method step in this claim that is actually directed toward a method of making a license plate. Rather, the method only includes the steps of “providing” and “displaying.” Nevertheless, because the claim purports to be a method of making, the *reason* for making (i.e., in order to use the indicia to identify the vehicle) is irrelevant.

Regarding claims 20-24, the paragraphs referred to as providing support for these claims (i.e., [0002], [0009], and [0016]) do not, in fact, even mention such things as “reading a metallic plate containing a combination of non-alphanumeric identification indicia used in the identification of vehicles,” and “comparing said combination of non-alphanumeric identification indicia to known vehicle registration records to determine ownership of a vehicle.” Neither do they mention “providing an insert of one or more conventionally recognized symbols as non-alphanumeric identification indicia,” “combining an insert . . .” or “substituting an insert . . .” These claims constitute new matter.

Finally, Applicant alleges that “there is a long felt need for” utilizing non-alphanumeric indicia for the purpose of identification. On the contrary, if any of the states that consciously prohibit such use had actually felt the need to allow it, all that state had to do was stop prohibiting itself from doing so. By the very act of prohibiting it, the state demonstrates its awareness that it could do that which it prohibited, if it desired.

Conclusion

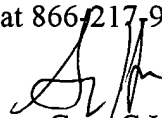
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch